

content of 0.004% to less than 0.5% and comprising about 95% to about 100% saturates wherein at least about 55% of the saturates are aliphatic saturates, and gear oil or transmission fluid additives comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.

27. (Twice Amended) A gear oil or transmission fluid composition comprising a major amount of a basestock and a gear oil or transmission fluid concentrate wherein the basestock comprises a major amount of a mineral oil having iodine number of less than 9, a sulfur content of 0.004% by weight to less than 0.5% by weight, a viscosity index of 120 or more, and comprises about 95% to about 100% saturates wherein at least 55% of the saturates are aliphatic saturate; the gear oil or transmission fluid concentrate comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.

**A version of the above amended claims marked to indicate the specific amendments may be found in the attached Appendix, in accordance with 37 CFR 1.121(c)(1).**

#### **REMARKS**

Claims 1, 7, 9, 14, 17-20 and 27 have been amended. Claims 1-27 are in the application. Entry of this amendment, and reexamination and reconsideration of the claims in this application are respectfully requested in light of the above amendments and the following remarks.

Claims 1, 17, 19, 20 and 27 have been amended to indicate that the mineral oil has a sulfur content of 0.004% by weight to less than 0.5% by weight. Support for this amendment can be found in the applicant's specification at page 6, lines 2-24, and original claim 20.

Claims 1, 17, 19, 20 and 27 have also been amended to indicate that the claimed composition contains a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof. Support for this amendment can be found in the applicant's specification at page 15, line 23 to page 18, line 3; page 21, line 7 to

page 25, line 3; page 32, line 11 to page 41, line 28; page 42, lines 16-24; and page 73, line 1 to page 74, line 24.

Claims 7, 9, and 14 have been amended to be consistent with the amendments to claim 1.

Claim 18 has been amended to correct a typographical error. The typographical error related to the dependency of the claim. Claim 18 was originally presented as depending from claim 9, but should have depended from claim 17.

Claims 1-27 have been rejected under 35 U.S.C. §103(a) as unpatentable over the teachings in Cody et al. (U.S. Patent 6,059,955) alone or in combination with the teachings in Smalheer et al. This rejection is respectfully traversed for the following reasons.

Cody et al. discloses a method of making a wax isomerate oil characterized by having a viscosity of from about 3.0 to 5.0 cSt at 100°C, a viscosity index from 110 to 160 and a saturates content greater than 98% (see, Cody et al. at column 1, lines 62-66). The reference also discloses an automatic transmission fluid comprising a major amount of an isoparaffinic basestock and a minor portion of an additive package comprising at least one of pour point depressant, viscosity index improvers, flow improver, detergents, inhibitors, seal swelling agents, antirust agents and antifoaming agents (see, Cody et al. at column 2, lines 26-34).

This reference indicates that sulfur and nitrogen compounds are undesirable in the wax isomerate oil and any fully formulated product made using such oil, and for this reason the reference indicates that the sulfur content of the oil is from 1 to 20 ppm and the nitrogen content is no more than 5 ppm (see, Cody et al. at column 4, lines 39-49). In contrast, the applicant's claims 1, 17, 19, 20 and 27 have been amended to specify that the mineral oil used in the claimed compositions has a sulfur content of 0.004% by weight to less than 0.5% by weight. Also, these claims have been amended to specify that the claimed compositions contain a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof. These amendments clearly distinguish the applicant's claims 1, 17, 19, 20 and 27 from the teachings in this reference. Accordingly, the applicant respectfully submits that the claims as amended herein are clearly distinguishable from and therefore not obvious over the teachings in Cody et al.

Smalheer et al. adds nothing to the teachings in Cody et al. that would be deemed sufficient to render the applicant's claims obvious. Smalheer et al. do not disclose or suggest adding a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof, to a gear oil or transmission fluid as specified in the applicant's amended claims 1, 17, 19, 20 and 27.

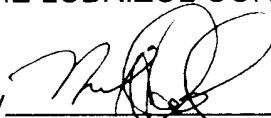
Withdrawal of the rejection of claims 1-27 under 35U.S.C. §103(a) over the teachings in Cody et al. alone or taken in combination with the teachings in Smalheer et al. is believed to be warranted and is respectfully requested.

Applicant believes that the application is now in condition for allowance. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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## **APPENDIX – VERSION WITH MARKINGS TO SHOW CHANGES**

Claims 1, 7, 9, 14, 17-20 and 27 have been amended as follows.

1. (Twice Amended) A gear oil or transmission fluid composition comprising a major amount of lubricant basestock and at least one functional additive wherein a major amount of the lubricant basestock comprises a mineral oil having a viscosity index of 120 or more, an iodine number of less than 9, a sulfur content of 0.004% by weight to less than 0.5% by weight, and comprising about 95% to about 100% by weight saturates wherein at least about 55% of the saturates are aliphatic saturates; the functional additive comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.

7. (Amended) The composition of claim 1 wherein the [functional additive is] composition further comprises [a] an antiwear or extreme pressure agent.

9. (Amended) The composition of claim 8 wherein the antiwear or extreme pressure agent is a [sulfurized olefin,] metal or ashless dithiocarbamate[, or mixtures of two or more thereof].

14. (Amended) The composition of claim 1 wherein the [functional additive is] composition further comprises at least one antioxidant.

17. (Twice Amended) A gear oil composition comprising at least one Group III basestock, at least one polymer having a weight average molecular weight of less than about 50,000, at least one fluidizing agent, and at least one functional additive, the Group III basestock comprising a major amount of a mineral oil having a viscosity index of 120 or more, an iodine number of less than 9, a sulfur content of 0.004% by weight to less than 0.5% by weight, and a saturates concentration of about 98% to about 100% by weight wherein at least about 55% by weight of the saturates are aliphatic saturates; the functional

additive comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.

18. (Amended) The composition of claim [9] 17 wherein the Group III basestock comprises greater than 80% by weight of the basestock of the composition.

19. (Twice Amended) A transmission fluid comprising at least one Group III basestock and at least one functional additive, the Group III basestock comprising a major amount of a mineral oil having a viscosity index of 120 or more, an iodine number of less than 9, a sulfur content of 0.004% by weight to less than 0.5% by weight, and a saturates concentration of about 98% to about 100% by weight wherein at least about 55% by weight of the saturates are aliphatic saturates; the functional additive comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.

20. (Twice Amended) A lubricant comprising a major amount of a mineral oil having an iodine number of less than 9, a viscosity index of 120 or more and a sulfur content of 0.004% by weight to less than 0.5% and comprising about 95% to about 100% saturates wherein at least about 55% of the saturates are aliphatic saturates, and gear oil or transmission fluid additives comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.

27. (Twice Amended) A gear oil or transmission fluid composition comprising a major amount of a basestock and a gear oil or transmission fluid concentrate wherein the basestock comprises a major amount of a mineral oil having iodine number of less than 9, a sulfur content of 0.004% by weight to less than 0.5% by weight, a viscosity index of 120 or more, and comprises about 95% to about 100% saturates wherein at least 55% of the saturates are aliphatic saturate; the gear oil or transmission fluid concentrate comprising a sulfurized olefin, or a salt derived from ammonia or an amine and a phosphorus acid ester, or a mixture thereof.